

**Amendments to the Drawings:**

The attached sheets of drawings include changes to Figures 1A and 1B. These sheets, which include Figures 1A and 1B, replace the original sheets including Figures 1A and 1B. In Figures 1A and 1B, previously incorrect labels have been corrected.

Attachment: Replacement Sheets (2)

## REMARKS

In response to the Office Action dated October 18, 2004, Applicant respectfully requests reconsideration based on the above claim amendment and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 2 and 13-19 have been canceled, without prejudice, and claims 1 and 11 have been amended. Claims 20-26 have been added, leaving claims 1, 3-12 and 20-26 for consideration upon entry of the present amendment. The drawings have been amended to correct errors pointed out by the Examiner. No new matter has been added by the amendment. Support for the amendment can be found at least on page 3 and Figures 2 and 3 of the application as originally filed.

### *Claim Rejections Under 35 U.S.C. §102(b)*

Claims 1, 6, 8-10, 12, 13, 16, 18 and 19 were rejected under 35 U.S.C. §102(b) as being anticipated by Chang, U.S. Patent No. 6,193,120. Applicant respectfully traverses.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is submitted that Chang fails to teach each and every element as set forth in the claim 1 for at least the reasons described below. Claims 13, 16, 18 and 19 have been cancelled without prejudice, thus the rejections of claims 13, 16, 18 and 19 are now moot.

Applicant has amended claim 1 to recite, *inter alia*, said ball retainer includes a retainer top and a retainer bottom and said retainer top is disposed so as to be separated from said retainer bottom via a ball cavity.

In contrast, Chang merely discloses a waist secured golf retainer having a ball cup (30) and snap pieces (34). The ball cup (30) is disposed around a bottom hemisphere of a golf ball and comprises a unitary element having snap pieces (34) disposed at intervals around the ball cup (30) in a same plane with respect to the ball cup (30) (see Fig. 4). Since the snap pieces (34), which act to retain the golf ball, are all in the same plane, the snap pieces (34) do not teach a retainer top and a retainer bottom. Additionally, since the ball cup (30) extends around a bottom hemisphere of the golf ball, the ball cavity in Chang does not separate a retainer top and a

retainer bottom. Thus, Chang fails to teach said ball retainer includes a retainer top and a retainer bottom and said retainer top is disposed so as to be separated from said retainer bottom via a ball cavity, as claimed in amended claim 1.

Accordingly, claim 1 is believed to be patentably distinct and nonobvious in view of Chang. Claims 6, 8-10 and 12 depend either directly or indirectly from claim 1, and thus include all the limitations of claim 1. Thus, claims 6, 8-10 and 12 are believed to be allowable for at least the reasons given for claim 1.

Accordingly, Applicant respectfully requests that the Examiner reconsider the rejections of claims 1, 6, 8-10 and 12 under 35 U.S.C. §102(b).

***Claim Rejections Under 35 U.S.C. §103(a)***

In order for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). See MPEP 2143.

**Claims 2-5 and 7**

Claims 2-5 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Harrison, U.S. Patent No. 6,168,061 in view of Tardiff et al., U.S. Patent No. D454,381 (hereinafter "Tardiff"). Applicant respectfully traverses. Claim 2 has been canceled, thus the rejection of claim 2 is moot.

Applicant has amended claim 1 to recite, *inter alia*, said ball retainer includes a retainer top and a retainer bottom and said circular top and bottom cavities expose opposite end portions of said at least one golf ball, such that only an annular portion near each opposite polar region of said at least one golf ball is in contact with said retainer top and said retainer bottom, respectively.

Harrison is directed to a golf ball holder having cup shaped portions (19) and (20) that lack a retainer top and retainer bottom (see Fig. 1). Additionally, Harrison does not teach that a golf ball retained in one of the cup shaped portions (19) and (20) is only in contact with a circular portion near each opposite polar region of the golf ball. Thus, Harrison fails to teach said ball retainer includes a retainer top and a retainer bottom and said circular top and bottom cavities expose opposite end portions of said at least one golf ball, such that only an annular portion near each opposite polar region of said at least one golf ball is in contact with said retainer top and said retainer bottom, respectively as recited in amended claim 1.

Tardiff is directed to a golf ball holder having a retainer at each of opposite end portions of a golf ball. There is no disclosure or suggestion in Tardiff that each retainer exposes opposite end portions of the golf ball. Additionally, in Tardiff, at least one polar region of a golf ball being retained is completely covered and in contact with the holder. Thus, Tardiff teaches a device that does not offer the ease of insertion and extraction of a golf ball as does the claimed invention in which only an annular portion of the at least one golf ball is in contact with the holder at opposite polar regions. Thus, Tardiff neither teaches nor suggests the circular top and bottom cavities expose opposite end portions of said at least one golf ball, such that only a circular portion near each opposite polar region of said at least one golf ball is in contact with said retainer top and said retainer bottom, respectively as claimed in amended claim 1. Thus the cited references do not render claim 1 obvious. Claims 3-5 and 7 depend directly or indirectly from claim 1, and thus include all the limitations of claim 1. The dependent claims 3-5 and 7 are patentable for at least the same reasons as given above for the independent claim 1.

Accordingly, Applicant respectfully requests the Examiner's reconsideration of the rejections of claims 3-5 and 7.

#### Claims 13-16, 18 and 19

Claims 13-16, 18 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over deLong, U.S. Patent No. D448,555. Claims 13-16, 18 and 19 were canceled, thus the rejections are now moot.

Claim 17

Claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Harrison in view of deLong. Claim 17 has been canceled, thus the rejection is now moot.

***Newly Added Claims***

Applicant has added new claims 20-26 to more particularly define aspects of the present invention. The new claims include no new matter and are fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claims are in condition for allowance.


***Conclusion***

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicant's attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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